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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,102	12/05/2003	Uwe Scheim	WAS 0613 PUS / Wa 10265-S	3087
22045	7590	07/20/2005	EXAMINER	
BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075			PENG, KUO LIANG	
			ART UNIT	PAPER NUMBER
			1712	

DATE MAILED: 07/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/729,102

Applicant(s)

SCHEIM ET AL.

Examiner

Kuo-Liang Peng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/9/05 Amendment.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7-19 is/are rejected.
- 7) ☐ Claim(s) 5, 6 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The Applicants' amendment filed on May 9, 2005 was received. Claims 1-2 and 11 amended. Claims 16-20 are added. Now, Claims 1-20 are pending.
2. Claim rejection(s) (except Claim 12) under 35 USC 112 in the previous Office Action (Paper No. 0205) is/are removed.
3. Claim rejection(s) under 35 USC 102 in the previous Office Action (Paper No. 0205) is/are removed.
4. The text of those sections of Title 35, U.S. code not included in this action can be found in a prior Office Action (Paper No. 0205).

Claim Rejections - 35 USC § 112

5. Rejection of Claim 12 under 35 USC 112 is maintained because the rejection is adequately set forth in paragraph 2 of Paper No. 0205. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

In Claim 12 (lines 3-4), “crosslinkers having at least three organooxy radicals” causes confusion because not all organooxy radicals can participate in the crosslinking reaction of the present invention.

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 11 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the use of silanes having at least three alkoxy radicals and/or their partial hydrolysates as component B) (page 13, 1st paragraph), does not reasonably provide enablement for any crosslinker having at least three Si-O bounded organooxy radicals. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

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8. Claims 16-17 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the molar ratio Si-OH/OR^2 being greater than or equal to 1 (page 8, 2nd paragraph), does not reasonably provide enablement for the ratio of Si-OH/OR^2 being less than 1. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

Claim Rejections - 35 USC § 103

9. Rejection of Claims 1-4 and 7-15 under 35 USC 103(a) as being unpatentable over JP167 (JP 63-083167) in view of Chung (US 4 495 331) is maintained because the rejection is adequately set forth in paragraph 6 of Paper No. 0205. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument in Remarks (page 8, 2nd paragraph), the argument regarding Chung's scavenger is irrelevant. Especially, the deactivator in the present invention can be up to 200% based on the molar amount of chain extenders. (See Claim 8)

For Applicants' argument in Remarks (page 8, 3rd paragraph), note that whether the isocyanates of the present invention are hydroxyl scavengers or not is irrelevant because in the instant claims, the function of the deactivator is not specified. Furthermore, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. In *re* Van Guens, 988 F. 2d 1811, 26 USPQ 2d 1057 (Fed. Cir. 1993) Furthermore, Chung's isocyanate as a hydroxy group-scavenger reads on Applicants' deactivator, it should be able to function whatever function Applicants' deactivator intends to do.

For Applicants' argument in Remarks (page 8, last paragraph to page 9, 2nd paragraph), note that the primary function of Chung's isocyanate is to scavenge hydroxy groups. Therefore, arguing that JP167 has already contained a water scavenger (i.e., aminomethyldialkoxysilane) and there is no need for another water scavenger is irrelevant. Furthermore, the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), *cert. denied*, 500 U.S. 904 (1991) (MPEP 2144)

For Applicants' argument in Remarks (page 9, 3rd paragraph), note that the arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) Furthermore, note that the composition in the present invention also contains a tertiary amine and an isocyanate.

10. Claims 18-19 are rejected under 35 USC 103(a) as being unpatentable over JP167 in view of Chung as applied to Claims 1-4 and 7-15 above, and further in view of Kratel (US 4 317 762).

JP167 further teaches the use of a plasticizer. page 4, upper right column)
JP167 is silent on the specific type of plasticizer. However, it is well known to use a phosphoric acid ester as a plasticizer in a RTV composition. For example, Kratel teaches the use of a phosphoric acid ester in a RTV composition comprising a hydroxy-capped polysiloxane and a silicon compound having at least 3 Si-bonded hydrolyzable groups. The motivation of using the phosphoric acid ester is to plasticize the composition. (col. 2, line 16 to col. 4, line 31 and col. 6, lines 1-24)
In light of the benefit mentioned, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate Kratel's phosphoric acid ester into JP167's composition. Kratel is silent on the amount of

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the phosphoric acid ester. However, the amount of the phosphoric acid ester will affect the properties of the composition such as viscosity, etc. In other words, the amount is a Result-Effective variable. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize the phosphoric acid ester in whatever amount through routine experimentation in order to obtain a composition having desired properties. Especially, Applicants do not show the criticality of the amount of the phosphoric acid ester. See MPEP 2144.05 (II).

11. Claims 5-6 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

None of Lucas, JP167, Chung and Kratel, taken alone or in combination, teaches or fairly suggests the process and the composition set forth in the instant claims.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**

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See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an

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application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp
July 18, 2005


Kuo-Liang Peng
Primary Examiner
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